

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Appeal of the Board of Patent Appeals and Interferences

In re **PATENT APPLICATION** of

Inventor(s): Martin, James

Appln. No.: 09

Series Code ↑

291,983

Serial N. ↑

Group Art Unit: 3724

Examiner.: C. Dexter

Atty. Dkt. P 259035

M#

HT-3031

Client Ref

Filed: April 15, 1999

Title: Low Profile Hacksaw

Date: January 16, 2003

RECEIVED

JAN 22 2003 1/23/03

Hon. Commissioner of Patents
Washington, D.C. 20231

TECHNOLOGY CENTER R3700

Sir:

1. ☐ **NOTICE OF APPEAL:** Applicant hereby appeals to the Board of Patent Appeals and Interferences from the decision (not Advisory Action) dated _____ of the Examiner twice/finally rejecting claim(s) in this application or in this application and its parent application.
2. ☐ **BRIEF** on appeal in this application attached in triplicate (extendable up to 5 months).
3. ☒ An **ORAL HEARING** is respectfully requested under Rule 194 (due two months after Examiner's Answer - unextendable)
4. ☒ Reply Brief is attached in triplicate (due two months after Examiner's Answer - unextendable).
5. ☐ "Small entity" statement filed: ☐ herewith. ☐ previously.
6. ☐ Fee **NOT** required because paid in prior appeal in which the Board of Patent Appeals and Interferences did not render a decision on the merits (35 USC 134).

7. FEE CALCULATION

	Large/Small Entity	Fee Code
If box 1 above is X'd, enter	\$320/160	\$0 119/219
If box 2 above is X'd, enter	\$320/160	\$0 120/220
If box 3 above is X'd, enter	\$280/140	\$280 121/221
If box 4 above is X'd, enter nothing	- 0 - (no fee)	
8. Original due date: February 20, 2003		
9. Petition is hereby made to extend the original due date (1 mo)	\$110/\$55	115/215
to cover the date this response is filed for which the (2 mos)	\$410/\$205	116/216
requisite fee is attached. (3 mos)	\$930/\$465	117/217
(4 mos)	\$1,450/\$725	118/218
(Usable only if box 2 is X'd--- 5 mos)	\$1,970/\$985	128/228
10. Enter any previous extension fee paid <input type="checkbox"/> previously since above		
Original due date (item 8); <input type="checkbox"/> with concurrently filed amendment	-\$0	
11. Subtract line 10 from line 9 and enter: Total Extension Fee		+\$0
12. TOTAL FEE =		\$280

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C#

259035

M#

CHARGE STATEMENT: The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficiencies only) now or hereafter relative to this application and the resulting Official Document under Rule 20, or credit any overpayment, to our Accounting/Order Nos. shown above, for which purpose a duplicate copy of this sheet is attached. This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal sheet is filed.

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NOTE: Fill this cover sheet in duplicate with PTO receipt (PAT-103A) and attachments



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of

MARTIN et al.

Application No: 09/291,983

Filed: April 15, 1999

For: LOW PROFILE HACKSAW

Group Art Unit: 3724

Examiner: C. Dexter

#31/Reply Brief
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JAN 22 2003 1/23/03

TECHNOLOGY CENTER R3700
V. Hart

* * * * *

January 16, 2003

REPLY BRIEF

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

Applicant hereby submits in triplicate this Reply Brief responsive to the Examiner's Answer dated December 20, 2002.

Withdrawal of the outstanding double patenting rejection is acknowledged and appreciated.

In response to the issues raised in the Examiner's Answer with respect to the still-pending obviousness rejection, the Applicant provides the following comments for the Board's consideration.

I. The Examiner's Answer Fails to Properly Indicate the Appeals Conference Required Per MPEP §1208

As an initial matter, the Applicant would like to point out that the Examiner's Answer fails to conform to MPEP §1208, which requires that an Appeals Conference take place and that the participants in the Appeals Conference initial the Examiner's Answer. No initials are provided on the Examiner's Answer. The Applicant requests that the Examiner provide a new copy of the Examiner's Answer properly initialed to confirm that such a Conference took place.

II. The Examiner's Statement re Claim Grouping is Erroneous

In the Appeal Brief of September 25, 2002,¹ the Applicant asserted that claims 3-9 and 16 stand separately patentable. In that Brief the Applicant also argued that the reasons supporting patentability are that, for each of these claims, the Examiner failed to establish the *prima facie* case of obviousness. The Letter accompanying the September 25th Appeal Brief confirms that position. However, the Examiner on page 2 in his Answer states that he disagrees with the Applicant's position that claims 3-9 and 16 are separately patentable on the basis that the Applicant has provided the same reasons of patentability for all those claims.

The Applicant submits that the Examiner misunderstands the burden of proof with respect to patentability. The Examiner has the burden of proof for establishing the *prima facie* case of obviousness against each of 3-9 and 16 individually. MPEP §2142 states that “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” (italics in original) Here, the Applicant asserts that the reason claims 3-9 and 16 are separately patentable is that, for each of these claims, the Examiner has failed to factually support a *prima facie* conclusion of obviousness as required by MPEP §2142. Specifically, the Examiner has simply stated mere conclusions as to the patentability of these claims and has provided no analysis of the elements of these claims in respect to the prior art. In particular, for claims 3-5 and 16, the Examiner has simply concluded that they are “met” by David and Wells, but has provided no explanation of how these references meet the claim limitations. Also, with respect to claims 6-9, he asserts that the claim limitations therein could be achieved by routine experimentation, but provides no analysis of how the prior art teaches or suggests those claim limitations. Accordingly, the Applicant submits that each of these claims are patentable over the art of record, as for each claim the Examiner has failed to make a proper *prima facie* rejection.

It appears that the Examiner's point of disagreement is that the Applicant has not detailed an affirmative rationale for patentability for each of claims 3-9 and 16.

¹ The Examiner rejected an earlier filed Appeal Brief for formalities reasons.

However, the allocation of the burden of proof requires the Examiner to first establish a prima facie case for each of these claims and this clearly has not been done.

Based on the foregoing, the Applicant maintains his position that claims 3-9 and 16 are separately patentable and respectfully requests the Board to find as such.

III. The Examiner's Response to Applicant's Argument Improperly Relies on Prior Not of Record

In the Examiner's Answer, the Examiner is attempting to rely on a number of prior art references not previously cited during prosecution. Specifically, the Examiner cites a laundry list of previously uncited patents cited in an improper attempt to establish that tubular members are equivalent or interchangeable with I-beam members. By citing these references, but not formally rejecting the claims on them, it appears the Examiner is simply attempting to circumvent the prohibition against raising new grounds of rejection set forth in MPEP §1208.01. Accordingly, the Board is requested to disregard these references and any arguments presented by the Examiner based upon these references.

IV. The Examiner's Response to Applicant's Argument Actually Supports the Applicant's Position of Non-Obviousness

In the Examiner's Answer, the Examiner has taken the position that tubular members and I-beam members are known for use as load supporting members. The Applicant has never disputed the fact that both tubular members and I beam members are known for this purpose. Instead, it is the Applicant's position that it is not obvious to use an I beam member with a profile as recited in the claims in the specific context of a hacksaw. Moreover, the Applicant submits that this position taken by the Examiner actually supports a finding of non-obviousness, as opposed to supporting a finding of obviousness.

Specifically, Wells establishes that a hacksaw with an arcuate frame member has been known since at least 1901. The Examiner insists that it is well known and established that I-beam members and tubular frame members are interchangeable. The Applicant submits that this evidence implicitly supports a finding of non-obviousness, as it establishes that those skilled in the art have had these constructions available to them, yet no one prior to the Applicant has ever conceived of combining them together to arrive at the superior hacksaw defined by the claims.

V. The Examiner's Assertions of Interchangeability and Equivalency Do Not Establish a Motivation

In his Answer, the Examiner repeatedly asserts that tubular members and I-beam members are interchangeable or equivalent. As far as equivalency is concerned, the Applicant is assuming that the Examiner means that an I-beam member has the same performance characteristics as a tubular frame member. The Applicant disagrees that they are equivalent, as no evidence has been provided establishing that such equivalency exists. To the contrary, stress created by a bending moment is distributed much differently in an I-beam member than in a tubular member. In particular, an I-beam member has superior resistance to deflection because of the upper and lower end caps which greatly increase the leading stiffness. Second, as far as interchangeability is concerned, the Applicant is assuming that the Examiner means that an I-beam member is capable of being substituted for a tubular member. Assuming for the sake of argument that the Examiner's position is correct, the mere fact that an I-beam member is capable of being substituted for a tubular member is not sufficient to provide the requisite motivation or suggestion for establishing the prima facie case of obviousness. See In re Mills, 916 F.2d 680, 682 (Fed.Cir. 1990)(stating that although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.").

Further, the laundry list of patents improperly cited by the Examiner in support of his assertion of interchangeability does not contain a single patent related to a hacksaw or an analogous device.² Thus, one skilled in the art would not look to these patents as being relevant; and even if one skilled in the art did look to these patents he/she would not find any motivation or suggestion to modify the hacksaw of Wells to change its essential tubular frame member to an I-beam frame member. Moreover, it appears that the Examiner has searched as broadly as he could through varying arts, yet has been unable to identify a single prior art reference providing a motivation or suggestion for modifying the hacksaw Wells to change its essential tubular frame member to an I-beam frame member.

² The patents cited by the Examiner relate to rail transportation, a snowmobile trailer, a small boat carrier, a boom sheave, submerged pipelines, a slide table for power tools, a workbench, and office furniture. Nothing in these patents bears any relation to hacksaws or analogous devices.

VI. The Examiner Continues to Improperly Rely on Official Notice

For the record, the Applicant has continuously objected to the Examiner's use of Official Notice in lieu of objective evidence. However, the Examiner continues to insist on using Official Notice, including using it as part of his prima facie case in the Examiner's Answer. The Applicant respectfully maintains his objection to the use of Official Notice.

VII. The Examiner's Statement Concerning Consideration of the Prior Art as a Whole is Misleading

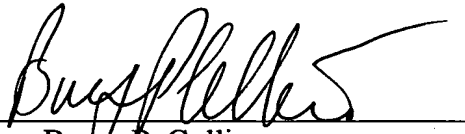
In the Examiner's Answer, the Examiner attempts to "shrug off" the Applicant's argument that Wells teaches a tubular frame member as being essential by baldly stating that the prior art as a whole must be considered. The Applicant's agree that all relevant prior art must be considered in making a decision on patentability. However, that does not relieve the Examiner from considering each individual prior art reference as a whole, including any portions thereof teaching away from the claimed invention. Wells clearly teaches that a tubular frame member is essential, and the Examiner cannot ignore this fact simply by citing to a laundry list of irrelevant references, none of which have even been properly made of record. Further, even though the prior art as a whole must be considered, the Examiner is required to identify the specific prior art references supporting his rejection. Here, he has only cited David and Wells, and any attempt to rely on the "prior art as a whole" without identifying specific teachings in an identifiable prior art reference is simply improper and should be ignored by the Board.

VIII. Conclusion

Based on the foregoing comments, in conjunction with the comments raised in the Appeal Brief, the Applicant respectfully requests the Board to reverse the outstanding obviousness rejection and remand the present application for issuance of a Notice of Allowance.

Respectfully submitted,

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